In the Drawings

There are no amendments to the drawings.

Remarks

The Examiner has rejected claims 1 – 5, 9 – 12 and 15 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,136,501 to Silverman et al. ("the '501 patent") in view of U.S. Patent No. 4,266,775 to Chitnis et al. ("the '775 patent"). The Examiner has further rejected Claims 6 – 8 under 35 U.S.C. §103(a) as being unpatentable over the '501 patent in view of the '775 patent and further in view of *Dictionary of Finance and Investment Terms*. The Examiner has still further rejected Claims 13 – 14 under 35 U.S.C. §103(a) as being unpatentable over the '501 patent in view of the '775 patent and further in view of U.S. Patent No. 4,677,552 to Sibley, Jr. ("the '552 patent"). The Examiner has yet further rejected Claims 16 – 17 under 35 U.S.C. §103(a) as being unpatentable over the '501 patent in view of the '775 patent and further in view of U.S. Patent No. 6,745,236 to Hawkins et al. ("the '236 patent"). These rejections are respectfully traversed.

35 U.S.C. §103(a) Rejections

Applicant respectfully submits that claim 1 requires among other elements,

1.   A "<u>database accessible by said computer containing a plurality of player files</u> associated with a plurality of players of the system wherein each of said plurality of player files contains a player portfolio associated with a specific player including commodities and units thereof and a money value";

2.   The "plurality of player files further containing <u>a player score determined</u> <u>by said computer</u> based on said player portfolio"; and

3.   "[S]oftware executing on said computer for . . . retrieving a player portfolio from said player database corresponding to the player . . . <u>updating said money value</u> in said retrieved player portfolio."

Initially it should be noted that the Examiner has indicated that the '501 patent does not teach or disclose item 1 above, but rather has taken Official Notice that it was old to maintain records of trader holdings and to manipulate them. (Official Action, p. 3). In connection therewith, the Examiner stated that "such a portfolio of commodity hold-ings would be necessary for a trader/player to know what his/her assets were. Retrieval and updating of a portfolio were old and well known portfolio accounting processes." (Official Action, p. 3). Even if this were the case, a trader accessing his/her portfolio to determine what their assets were and for accounting purposes does not meet the limita-tions of: a computer accessible by a plurality of players over a computer network; a <u>da-</u> <u>tabase accessible by said computer containing a plurality of player files</u> associated with a plurality of players of the system wherein each of said plurality of player files contains a player portfolio associated with a specific player; and <u>software</u> executing on said com-puter for <u>retrieving a player portfolio from said player database</u> corresponding to the player updating said money value in said retrieved player portfolio required by Claim 1.

While the '501 patent may disclose a computer for receiving bids, nowhere does the '501 patent teach, disclose or suggest providing a database including a trader specific portfolio of information as required by Claim 1. The Examiner has submitted that it would be obvious to modify the '501 patent to include portfolio management, however this extends well beyond the scope and objects of the '501 patent, which is directed toward a system for automatically matching bids against available trading instruments. (Abstract). There is absolutely no provision or suggestion in the '501 patent for extending this automatic matching system into a portfolio management system for managing individual traders own portfolios. Likewise, there is absolutely no suggestion in the '775 patent for providing such a database accessible by the computer.

The Examiner has submitted that Applicant has provided no evidence that such a central database is new, citing for example, U.S. Patent No. 6,601,044 ("the '044 patent"). (Official Action, p. 8). However, Applicant respectfully submits that it is the specific combination of elements in Claim 1 that is novel, not simply the provision of a database. For example, the '044 patent is directed toward a "computer-based system . . . for creating a portfolio of assets and executing trades in the assets to modify the portfolio" with "a first processor interfaced with an investor's PC to select a plurality of assets to be in the investor's portfolio based on the investor's indicated preferences." (abstract). Therefore, the '044 patent is directed toward a portfolio management system, whereas the '501 patent is directed toward an automated bid/commodity matching system.

It is well settled that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). The Examiner has provided no suggestion in the references themselves supporting an obviousness objection. It is also well settled that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). In the present case, Applicant respectfully submits that any attempt to expand the scope of the '501 patent to include the portfolio management system of the '044 patent would result in a much more complicated system. To include the portfolio management system would require the system taught in the '501 paten to be redesigned so as to account for and interface with the formatting of the PC based individual portfolio management system of the '044 patent. It is unclear if such a modification of the '501 patent according to the teachings of the '044 patent would actually be possible, let alone be obvious.

Additionally, there are ethical concerns with having one system control both an individual's portfolio and the trading transactions themselves. It is unclear if the individual portfolio system, which primary purpose is to manage and increase the value of the person's portfolio could actually be combined with the system that consummates the trades, which is supposed to match only the highest bid with the commodity. For example, the system of the '501 patent is supposed to match the highest bid for the commod-

ity listed in order to obtain the best price for the commodity for the seller. However, the

individual portfolio management system taught in the '044 patent is supposed to in-

crease the value of the individual portfolio, making commodity purchases at the lowest

possible price. There is an inherent tension between the two systems such that they

could not be combined because the systems have opposing objectives and therefore

such a combination could not be obvious. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125

(Fed. Cir. 1984). While the Examiner has not actually cited the '044 patent in combina-

tion with the '501 patent, Applicant submits that it would not be obvious to modify the

'501 patent with such a portfolio management system as taught in the '044 patent to ar-

rive at the present claimed invention as these systems are inherently incompatible.

It should be noted however, that none of these problems are ever encountered

by the present invention because this trading simulation is simply <u>a game</u>. All the in-

formation is generated by the game system and held in a central location. The privacy

concerns, monitoring and control issues, and ethical/fraud concerns that individuals and

governmental agencies have with real money do not come into play with the game sys-

tem of the present invention. Therefore, the novel combination of a central computer, a

database accessible by said computer containing a plurality of player files associated

with a plurality of players of the system wherein each of said plurality of player files con-

tains a player portfolio associated with a specific player including commodities and units

thereof and a money value, and software executing on said computer for retrieving a

player portfolio from said player database corresponding to the player updating said

money value in said retrieved player portfolio, is possible with the present game system as required by Claim 1.

Claim 1 further requires a plurality of player files further containing <u>a player score</u> <u>determined by said computer</u> based on said player portfolio. The Examiner has taken official notice that an accumulated portfolio value would constitute a score. (Official Action, p. 8). While a total monetary value would provide an individual with information as to how he/she was doing, this would provide absolutely no information with how the individual performed relative to the other players. This is the entire point of keeping score in a game, to indicate to everyone who performed at the highest level and determine an individual winner among the group of players. Simply providing a total portfolio value to an individual does not let him/her know how they did relative to anyone else nor does it allow a group of players to determine who the winner was.

The portfolio management system taught in the '044 patent has no provision for indicating to other investors the portfolio value of the individual, nor does the '501 patent. The '775 patent does teach keeping a score, however, the '775 patent fails to teach a plurality of player files further containing <u>a player score determined by said computer</u> based on said player portfolio as required by Claim 1.

In view of the foregoing arguments, Applicant respectfully submits that because neither the '501 patent nor the '775 patent teach, disclose or suggest a <u>database accessible by said computer containing a plurality of player files</u> associated with a plurality

of players of the system wherein each of said plurality of player files contains a player

portfolio associated with a specific player including commodities and units thereof and a

money value and software executing on said computer for retrieving a player portfolio

from said player database corresponding to the player updating said money value in

said retrieved player portfolio as required by Claim 1, no combination can render Claim

1 obvious.

In addition, Applicant further submits that modification of the '501 patent based

on a system as taught in the '044 patent cannot be obvious as these systems are inher-

ently incompatible. Therefore, the cited combination fails to teach a <u>database accessi-

ble by said computer containing a plurality of player files</u> associated with a plurality of

players as required by Claim 1. Still further, Applicant submits that the cited combina-

tion fails to teach, disclose or suggest a plurality of player files further containing <u>a

player score determined by said computer</u> based on said player portfolio as required by

Claim 1. Even assuming the portfolio value can indicate how a player is doing, this

does not constitute a score because the players cannot determine how they are doing
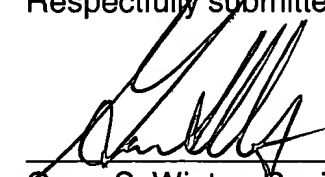
relative to each other to determine a winner.

Applicant still further submits that Claim 2 requires among other limitations <u>a da-

tabase containing game rules</u> for controlling the game flow and processing of indica-

tions, <u>said game rules including scoring criteria and game-ending criteria</u>, and <u>software

. . . determining a player score based on said player portfolio . . . retrieving said game-

ending criteria . . . ceasing further game play when said game-ending criteria are met.</u>

Clearly none of these limitations are taught, disclosed or suggested in any of the prior

art references.

While the Examiner has submitted that a total portfolio value equates to a player

score, nowhere does the cited art suggest a database containing game-ending criteria

and ceasing further game play when said game-ending criteria are met. Rather, be-

cause the '501 patent is directed toward a portfolio management system for real money,

there can be no "game-ending criteria" because it is not a game. While the '775 patent

is a game, there is no suggestion therein for generation of a database containing game

rules or software for determining a player score or software for determining a winner

and ceasing game play. Applicant therefore respectfully submits that Claim 2 cannot be

obvious in view of the cited references.

It is respectfully submitted that claims 1 – 17, all of the claims remaining in the

application, are in order for allowance and early notice to that effect is respectfully re-

quested.

Respectfully submitted,

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